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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,249	06/20/2003	Cynthia Kae Florkey	LUC-412/Florkey 6-6-14-6-	6690
32205 7590 01/05/2007 CARMEN B. PATTI & ASSOCIATES, LLC ONE NORTH LASALLE STREET 44TH FLOOR CHICAGO, IL 60602			EXAMINER COULTER, KENNETH R	
			ART UNIT 2141	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS			MAIL DATE 01/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/601,249

Applicant(s)

FLORKEY ET AL.

Examiner

Kenneth R. Coulter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:

The Application number and filing date of the related Application is not disclosed in the specification (p. 1).

Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Independent claim 20 is directed to signal that is not implemented on a computer-readable signal-bearing **storage** medium.

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure

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and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1 – 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 12 of copending Application No. 10/600,109. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because the claims of the present Application are a broad version of the claims of '109.

The following mapping applies:

Claim 1 of the present Application maps to claim 1 of '109.

Claim 2 of the present Application maps to claim 2 of '109.

Claim 3 of the present Application maps to claims 1 and 2 of '109.

Claim 4 of the present Application maps to claims 1 and 2 of '109.

Claim 5 of the present Application maps to claims 1 – 3 of '109.

Claim 6 of the present Application maps to claims 1 – 3 of '109.

Claim 7 of the present Application maps to claims 1, 2, 4 of '109.

Claim 8 of the present Application maps to claims 1 – 3 of '109.

Claim 9 of the present Application maps to claims 1, 2, 4 of '109.

Claim 10 of the present Application maps to claim 10 of '109.

Claim 11 of the present Application maps to claim 10 of '109.

Claim 12 of the present Application maps to claim 11 of '109.

Claim 13 of the present Application maps to claim 12 of '109.

Claims 14 – 20 map similarly.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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6. Claims 1, 14, and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 26 and 34 of copending Application No. 10/685,778. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present Application are a broad version of the claims of '778.

The following mapping applies:

Claim 1 of the present Application maps to claims 26 and 34 of '778.

Claim 14 of the present Application maps to claims 26 and 34 of '778.

Claim 20 of the present Application maps to claims 26 and 34 of '778.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1 – 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Marquette et al. (U.S. Pat. Pub. No. 6,499,053) (Master/Slave Architecture for a Distributed Chat Application in a Bandwidth Constrained Network).

8.1 Regarding claim 1, Marquette discloses an apparatus, comprising:

an application server component that receives an indication of one or more communication devices that are to receive one or more invitations to join a communication session (Abstract “an invitor user initiates, or adds a member to, a chat session by sending an invitation to an invitee user name at a proxy address at the chat server.”; Fig. 1);

wherein the application server component notifies the one or more communication devices of the one or more invitations to join the communication session (Abstract; Fig. 1; col. 2, lines 27 – 48; col. 3, line 65 – col. 4, line 10);

wherein upon acceptance of one or more of the one or more invitations by one or more of the one or more communication devices, the application server component connects the one or more of the one or more communication devices to the communication session (Abstract; Figs. 3, 4; col. 2, lines 27 – 48; col. 4, lines 36 – 50).

8.2 Per claim 2, Marquette teaches the apparatus of claim 1, wherein the one or more communication devices comprise one or more first communication devices; wherein the application server component receives the indication of the one or more

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first communication devices from one or more second communication devices (Figs. 1, 4; col. 2, lines 38 – 48).

8.3 Regarding claim 3, Marquette discloses the apparatus of claim 2, wherein the one or more second communication devices are involved in the communication session; wherein the application server component notifies the one or more first communication devices of the one or more invitations to join the communication session with the one or more second communication devices (Figs. 1, 4; col. 2, lines 38 – 48).

8.4 Per claim 4, Marquette teaches the apparatus of claim 3, wherein the application server component identifies a match between the one or more invitations and the acceptance of the one or more of the one or more invitations; wherein the application server component employs the match to indicate to one or more control components a call identification of the communication session (Figs. 1, 3, 4; col. 2, lines 38 – 48; col. 4, lines 36 – 50); wherein the one or more control components employ the call identification to connect the one or more of the one or more first communication devices to the one or more second communication devices in the communication session (Figs. 1, 3, 4; col. 2, lines 38 – 48; col. 4, lines 36 – 50).

8.5 Regarding claim 5, Marquette discloses the apparatus of claim 2, wherein the one or more first communication devices comprise a communication device, wherein the application server component activates an indicator of an invitation of the one or

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more invitations on the communication device, wherein the indicator persists until an action occurs on the invitation (Figs. 1, 3, 4; col. 2, lines 38 – 48).

8.6 Per claim 6, Marquette teaches the apparatus of claim 5, wherein the indicator persists on a display of the communication device, wherein upon the acceptance of the invitation by the communication device, the user of the communication device employs the indicator to initiate a connection to the communication session; wherein the application server component connects the communication device to the communication session (Figs. 1, 3, 4; col. 2, lines 38 – 48).

8.7 Regarding claim 7, Marquette discloses the apparatus of claim 5, wherein the action comprises an acceptance of the invitation by the communication device (Figs. 1, 3, 4; col. 2, lines 38 – 48); wherein upon receipt of the acceptance of the invitation by the communication device, the application server component sends one or more notifications of the acceptance of the invitation by the communication device to the one or more second communication devices (Figs. 1, 3, 4; col. 2, lines 38 – 48; col. 4, lines 36 – 50).

8.8 Per claim 8, Marquette teaches the apparatus of claim 5, wherein the action comprises a withdrawal of the invitation by one or more of the one or more second communication devices; wherein prior to an acceptance of the invitation, the one or more of the one or more second communication devices send the withdrawal to the

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application server component (Figs. 1, 3, 4; Abstract; col. 2, lines 13 – 25; col. 3, lines 42 – 64).

8.9 Regarding claim 9, Marquette discloses the apparatus of claim 8, wherein upon receipt of the withdrawal, the application server component removes the indicator of the invitation from the communication device (Figs. 1, 3, 4; Abstract; col. 2, lines 13 – 25; col. 3, lines 42 – 64).

8.10 Per claim 10, Marquette teaches the apparatus of claim 5, wherein the action comprises a rejection of the invitation by the communication device (Figs. 1, 3, 4; Abstract; col. 2, lines 38 – 48; col. 4, lines 36 – 50); wherein prior to an acceptance of the invitation, the communication device sends the rejection to the application server component (Figs. 1, 3, 4; Abstract; col. 2, lines 38 – 48; col. 4, lines 36 – 50).

8.11 Regarding claim 11, Marquette discloses the apparatus of claim 10, wherein upon receipt of the rejection, the application server component sends one or more notifications of the rejection to the one or more second communication devices (Figs. 1, 3, 4; Abstract; col. 2, lines 38 – 48; col. 4, lines 36 – 50).

8.12 Per claim 12, Marquette teaches the apparatus of claim 5, wherein the action comprises a completion of the communication session (Figs. 1, 3 – 5; Abstract; col. 2, lines 38 – 48; col. 4, line 51 – col. 5, line 13); wherein upon completion of the

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communication session prior to an acceptance of the invitation, the application server component sends a notification to the communication device of the completion of the communication session; wherein the application server component removes the indicator of the invitation from the communication device (Figs. 1, 3 – 5; Abstract; col. 2, lines 38 – 48; col. 4, line 51 – col. 5, line 13).

8.13 Regarding claim 13, Marquette discloses the apparatus of claim 1, wherein the communication session comprises a voice conference call, wherein upon acceptance of an invitation of the one or more invitations by a communication device of the one or more communication devices, the application server component connects a user of the communication device into a voice conversation with one or more participants in the communication session (Abstract “chat”; col. 1, lines 26 – 35 “voice users”; col. 2, lines 27 – 48; col. 4, lines 36 – 50).

8.14 Per claims 14 – 20, the rejection of claims 1 – 13 under 35 USC 102(e) (paragraphs 8.1 – 8.13 above) applies fully.

9. Claims 1 – 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilcock.

9.1 Regarding claim 1, Wilcock discloses an apparatus, comprising:

an application server component that receives an indication of one or more communication devices that are to receive one or more invitations to join a communication session (Abstract; Figs. 1 – 3; paragraphs 137, 146);

wherein the application server component notifies the one or more communication devices of the one or more invitations to join the communication session (Abstract; Figs. 1 – 3; paragraphs 55, 85, 102, 137, 146);

wherein upon acceptance of one or more of the one or more invitations by one or more of the one or more communication devices, the application server component connects the one or more of the one or more communication devices to the communication session (Abstract; Figs. 1 – 3; paragraphs 55, 79, 85, 102, 137, 146).

9.2 Per claim 2, Wilcock teaches the apparatus of claim 1, wherein the one or more communication devices comprise one or more first communication devices; wherein the application server component receives the indication of the one or more first communication devices from one or more second communication devices (Abstract; Figs. 1 – 3; paragraphs 55, 79, 85, 102).

9.3 Regarding claim 3, Wilcock discloses the apparatus of claim 2, wherein the one or more second communication devices are involved in the communication session (Figs. 1 – 3; paragraphs 85, 325); wherein the application server component notifies the one or more first communication devices of the one or more invitations to join the communication session with the one or more second communication devices (Figs. 1 –

3; paragraphs 85, 325).

9.4 Per claim 4, Wilcock teaches the apparatus of claim 3, wherein the application server component identifies a match between the one or more invitations and the acceptance of the one or more of the one or more invitations; wherein the application server component employs the match to indicate to one or more control components a call identification of the communication session (Figs. 1 – 3; paragraphs 59, 79, 85, 102, 325); wherein the one or more control components employ the call identification to connect the one or more of the one or more first communication devices to the one or more second communication devices in the communication session (Figs. 1 – 3; paragraphs 59, 79, 85, 102, 325).

9.5 Regarding claim 5, Wilcock discloses the apparatus of claim 2, wherein the one or more first communication devices comprise a communication device, wherein the application server component activates an indicator of an invitation of the one or more invitations on the communication device, wherein the indicator persists until an action occurs on the invitation (Fig. 17; paragraphs 59, 79, 85, 102, 224, 225, 325).

9.6 Per claim 6, Wilcock teaches the apparatus of claim 5, wherein the indicator persists on a display of the communication device, wherein upon the acceptance of the invitation by the communication device, the user of the communication device employs the indicator to initiate a connection to the communication session; wherein the

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application server component connects the communication device to the communication session (Fig. 17; paragraphs 59, 79, 85, 102, 224, 225, 325).

9.7 Regarding claim 7, Wilcock discloses the apparatus of claim 5, wherein the action comprises an acceptance of the invitation by the communication device (paragraphs 55, 85, 102, 137); wherein upon receipt of the acceptance of the invitation by the communication device, the application server component sends one or more notifications of the acceptance of the invitation by the communication device to the one or more second communication devices (paragraphs 55, 85, 102, 137).

9.8 Per claim 8, Wilcock teaches the apparatus of claim 5, wherein the action comprises a withdrawal of the invitation by one or more of the one or more second communication devices; wherein prior to an acceptance of the invitation, the one or more of the one or more second communication devices send the withdrawal to the application server component (paragraphs 55, 85, 102, 137).

9.9 Regarding claim 9, Wilcock discloses the apparatus of claim 8, wherein upon receipt of the withdrawal, the application server component removes the indicator of the invitation from the communication device (paragraphs 55, 85, 102, 137).

9.10 Per claim 10, Wilcock teaches the apparatus of claim 5, wherein the action comprises a rejection of the invitation by the communication device (Fig. 17; paragraphs

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59, 79, 85, 102, 224, 225, 325); wherein prior to an acceptance of the invitation, the communication device sends the rejection to the application server component (Fig. 17; paragraphs 59, 79, 85, 102, 224, 225, 325).

9.11 Regarding claim 11, Wilcock discloses the apparatus of claim 10, wherein upon receipt of the rejection, the application server component sends one or more notifications of the rejection to the one or more second communication devices (paragraphs 55, 85, 102, 137).

9.12 Per claim 12, Wilcock teaches the apparatus of claim 5, wherein the action comprises a completion of the communication session (paragraphs 55, 85, 102, 137); wherein upon completion of the communication session prior to an acceptance of the invitation, the application server component sends a notification to the communication device of the completion of the communication session; wherein the application server component removes the indicator of the invitation from the communication device (paragraphs 55, 85, 102, 137).

9.13 Regarding claim 13, Wilcock discloses the apparatus of claim 1, wherein the communication session comprises a voice conference call, wherein upon acceptance of an invitation of the one or more invitations by a communication device of the one or more communication devices, the application server component connects a user of the

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communication device into a voice conversation with one or more participants in the communication session (paragraphs 63, 116 “voice chat”).

9.14 Per claims 14 – 20, the rejection of claims 1 – 13 under 35 USC 102(b) (paragraphs 9.1 – 9.13 above) applies fully.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gudjonsson et al. U.S. Pat. No. 6,564,261 Distributed System to Intelligently Establish Sessions Between Anonymous Users Over Various Networks

A multi-user communication session, wherein a user may ask another user to join the communication session. Includes a voice chat session capability; accept/decline session capability; and notification of the online status of other users and/or change of status of other users.

Miladinovic et al. Multiparty Conference Signaling Using the Session Initiation Protocol (SIP); July 2002

Conferencing system that allows users to invite other users via a conference server.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KENNETH R. COULTER
PRIMARY EXAMINER


krc